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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,360	03/12/2004	Toshikazu Kikuchi	STAFU-82364	7940
24201	7590	08/03/2010		
FULWIDER PATTON LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE, TENTH FLOOR LOS ANGELES, CA 90045			EXAMINER TRUONG, KEVIN THAO	
			ART UNIT	PAPER NUMBER
			3734	
			MAIL DATE	DELIVERY MODE
			08/03/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/800,360

**Applicant(s)**

KIKUCHI ET AL.

**Examiner**

Kevin T. Truong

**Art Unit**

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-39 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Note: This is in response the amendment filed 10/07/2009.

#### ***Election/Restrictions***

The restriction requirement between patentably distinct species, as set forth in the Office action mailed on 08/26/2007, has been reconsidered in view of the present Reissue application. **The restriction requirement is hereby withdrawn.** Note that claims 21-37 directed to species that are no longer being withdrawn from consideration.

#### ***Reissue Application***

##### **Recapture:**

Claims 1-39 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the

application for the patent cannot be recaptured by the filing of the present reissue application.

In the amendment of 6/25/01 in the parent patented file, US Pat. 6355046, the applicant's attorney, John Palmer, amended at least claim 4 (today's patent claim 1) by adding/amending the limitations regarding "having an open position for receiving and holding the deformable intraocular lens and a closed position for holding the deformable intraocular lens in an enclosed manner, wherein at least only a peripheral edge portion of the deformable intraocular lens is engaged with said enclosing member when the deformable intraocular lens is placed received in the enclosing member and the enclosing member is in the open position, wherein the optical portion of the deformable intraocular lens substantially does not come into contact with the enclosing member when the enclosing member is in the open position, and wherein the deformable intraocular lens is deformed into a smaller size when the deformable intraocular lens is in the enclosing member and the enclosing member is closed from the open position to the closed position.". The applicant's attorney also argued such added/amended limitations are patentable over the art. (See pages 15-19 of the Remarks in the amendment). In particular, bottom of page 15 of the Remarks of 6/25/01, the applicant's attorney argued that the amendment to the claims is patentably over the Nakajima patent. In view of the totality of the arguments and the amendments to the claims, subsequently, the examiner allowed that application. Today, the applicant presented amended/new claims 1 and 39 without such limitations. These added/amended

limitations in the amendment to claim 4 of 6/25/01 are "surrendered material" that the applicant is now trying to recapture. This constitutes impermissible recapture.

### **Assignee Consent**

On 7/14/04, Applicant provided a statement of assignment with Cannon Staar Co. Inc. as assignee. However, on 6/3/08, the US Pat. 6355046 shows there was an assignment filed and recorded. The current assignment as of 6/3/08 belongs to Cannon Starr Co. Inc. recorded in Reel 021099 at Frame 0544 recorded on 6/3/08. Therefore, there is no correct assignee consent filed in the case. A new assignment to reflect the current assignee is required reissue in accordance with 37 CFR 1.172(a).

### ***New Supplemental Declaration Required***

1. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-39 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

See MPEP § 1414.01. A supplemental oath/declaration under 37 CFR 1.175(b) (1) is needed to cover errors corrected by amendment filed 4/9/08 (add or delete or amend claims after filing the Declaration on 3/12/04). To cure this defect, applicant should use Form PTO/SB/51S which maybe downloaded from the USPTO website. See MPEP § 1444 for handling supplemental oaths/declarations. The reissue claims broaden the scope of the patented claims in at least one respect even though they are narrower in other respects. MPEP 1412.03(I). Therefore, the new Declaration must be signed by all inventors (not the assignee). MPEP 1414.01 (III). See also *In re Hayes*, 53 USPQ 2d 1222.

A new reissue oath must properly identify at least one 35 U.S.C.251 error as amended in the claims of 4/9/08. The oath /declaration must specifically identify an error. Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. (MPEP 1414 II. (C)). The errors mentioned and corrected in the reissue oath/declaration of 7/14/04 are no longer there because the applicant twice amended those amended/added new independent claims 1 and 39. The differences between the newly amended/added independent claims 1 and 39 and the original claims 1-37 should be pointed out and explained (MPEP 1414).

### ***Claims***

(a) Amendment filed 4/9/08 failed to comply with 37 CFR 1.173. Pursuant to 37 CFR 1.173(c), each new claim added to the reissue by the amendment being submitted, the entire text of the added claim must be

presented completely underlined (MPEP 1453 II (B)). Therefore, newly added claims 38-39 in the amendment of 4/9/08 need to be underlined. Form paragraph 14.21.01 may be used for this 37 CFR 1.173(b) informality. There is no compliance with the requirement of 37 CFR 1.173 to point out where there is support for the amendment of claims 38-39. Please request applicant to provide the proper support.

(b) Amendment filed 4/9/08 failed to comply with 37 CFR 1.173((b) (2)). All amendments in the reissue application must be made relative to (i.e., vis- à-vis) the patent specification in effect as of the date of the filing of the reissue application. The patent specification includes the claims and drawings. All amendments subsequent to the first amendment 3/12/04 must also be made relative to the patent specification in effect as of the date of the filing of the reissue application, and **not** relative to the prior amendment (37 CFR 1.173(g)). Therefore, claims 1, 2, 14, 19, 20, 38 and 39 of amendment filed 4/9/08 need to be underlined for insertion and brackets for deletions.

### ***Response to Arguments***

2. Applicant's arguments filed 10/07/2009 have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 1-20, 38, and 39 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin T. Truong whose telephone number is 571-272-4705. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/  
Primary Examiner, Art Unit 3734

Kevin T. Truong  
Primary Examiner  
Art Unit 3734